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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,810	03/12/2004	William W. Shumway	HES 2003-IP-012703U1	8358

28857 7590 11/15/2006  
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EXAMINER
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FIGUEROA, JOHN J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,810	<b>Applicant(s)</b> SHUMWAY ET AL.	
	<b>Examiner</b> John J. Figueroa	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 and 63-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 and 63-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The objection to the specification is maintained for the reasons previously made of record in item 8 on page 4 of the Office Action of July 15, 2006, hereinafter 'OA'.
2. The double patenting rejection in item 10 on page 5 of OA has been withdrawn in view of the Terminal Disclaimer filed with Applicant's amendment/response of September 6, 2006, hereinafter 'Response'.
3. The 35 U.S.C. 102 rejection of claims 1-9, 11-17, 19-21, 23-34, 36-41, 63, 65 and 66 as anticipated by United States Patent Number (USPN) 5,990,050 to Patel et al., hereinafter 'Patel' is maintained for the reasons previously made of record in item 12 on page 6 of OA.
4. The 35 U.S.C. 103 rejection of claims 18, 22 and 35 as unpatentable over Patel in view of "Amphiphilic Copolymers" to Perrin, hereinafter 'Perrin' is maintained for the reasons previously made of record in item 14 on page 8 of OA.
5. The 35 U.S.C. 103 rejection of claims 10 and 64 as unpatentable over Patel in view of "Crude Oil Emulsions: A State of the Art Review" to Kokal, hereinafter 'Kokal' is maintained for the reasons previously made of record in item 15 on page 9 of OA.

### ***Election/Restrictions***

6. Applicant's affirmation of the election provisionally made with traverse of Group I, claims 1-41 and 63-66 in the reply filed on September 6, 2006 is acknowledged. There were no arguments presented regarding the grounds for the traversal of the restriction.

The requirement is still deemed proper and is therefore made FINAL.

### ***Response to Arguments***

#### ***The Objection to the Specification (item 8 of OA)***

7. Applicant's arguments with respect to the objection to the specification in item 8 of OA have been fully considered but are deemed unpersuasive.

Applicant's arguments concerning the specification providing "appropriate generic terminology" for the trademarks at issue (i.e., ACCOLADE™, PETROFREE®, ALCOSPERSRE®747 and ALCOQUEST®747) is incorrect. The specification disclosing these trademarks as either an olefinous fluid or a "commercially available polymer" is insufficient generic description to a person of ordinary skill in the art to be able to recognize the material chemical structural aspects of these components of the claimed treatment fluid.

Applicant's reliance on the statement cited from MPEP § 2173.05(u), regarding the "trademark or trade name ... used to identify a source of goods, and ... not identify[ing] or describe[ing] the goods associated with the trademark or tradename" is both misguided and misdirectional. First, this section of the MPEP concerns the use of

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trademarks in a *claim*. Moreover, this cited MPEP statement serves as further justification for requiring sufficient generic description in the specification to allow one skilled in the art to be able to ascertain, with some degree of definiteness, what the goods (fluid, polymers) actually consist of to provide an understanding and ability to practice the claimed invention, and not just merely recognize their source of origin. See MPEP 608.01(v):

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. *In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language.* Ex Parte Kattwinkle, 12 USPQ 11 (Bd. App. 1931).

However, if the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning, it constitutes sufficient identification *unless some physical or chemical characteristic of the article or material is involved in the invention*. In that event, as also in those cases where the trademark has no fixed and definite meaning, *identification by scientific or other explanatory language is necessary*. In re Gebauer-Fuelnegg, 121 F.2d 505, 50 USPQ 125 (CCPA 1941). The matter of sufficiency of disclosure must be decided on an individual case-by-case basis. In re Metcalfe, 410 F.2d 1378, 161 USPQ 789 (CCPA 1969). [Emphasis added.]

Accordingly, because the physical/chemical characteristics of the instant trademarks disclosed in the specification have no fixed or definite meaning, a scientific explanation is necessary that provides sufficient certainty of the chemical characteristics

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of the fluids and polymers encompassed by said trademarks so that a person skilled in the art can ascertain the claimed invention.

Thus, this objection to the specification is maintained.

*The Double Patenting Rejections (item 10 of OA)*

8. Applicant's arguments with respect to the obviousness-type double patenting rejection in item 10 of OA have been considered but have become moot due to the withdrawal of this rejection in view of the filing of the Terminal Disclaimer with Response.

*The 35 U.S.C. 102 Rejection over Patel (item 12 of OA)*

9. Applicant's arguments with respect to the 35 U.S.C. 102 rejection of claims 1-9, 11-17, 19-21, 23-34, 36-41, 63, 65 and 66 as anticipated by Patel have been fully considered but are deemed unpersuasive.

Applicant's arguments concerning Patel disclosing a surfactant as the emulsifying agent in preferred embodiments is misdirectional. Applicant's reliance on VERSACOAT® as the emulsifying agent used in the Examples is misguided.

"Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments." *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843

(Fed. Cir.), *cert. denied*, 493 U.S. See MPEP 2123. Thus, the Patel reference should be viewed as a whole and it is prior art for all it contains therein.

As discussed on page 7 of OA:

Patel discloses the drilling fluid to further contain *wetting agents or emulsifiers*, such as crude tall oil, oxidized crude tall oil, alkyl aromatic sulfates and sulfonates; organophilic clay; an oil-soluble polymer or a polyamide resin as a viscosifier; weighting agents; fluid loss control agents; and corrosion inhibitors, such as silicates. (*Col. 5, lines 1-15 and 22-63*) Patel lists a series of emulsifiers ... followed by an alternate, separate list of surfactants, which can be instead used to produce or stabilize the invert-emulsion. Thus, Patel does not require that the invert-emulsion contain a surfactant. [Emphasis added.]

Patel in col. 5, lines 1-15 (cited in OA) discloses:

The fluids of the present invention may further contain additives depending upon the end use of the drilling fluid or invert emulsion so long as the additives do not interfere with the properties of the fluids described herein. For example, *wetting agents*, organophilic clays, viscosifiers, weighting agents, bridging agents, fluid loss control agents, and corrosion inhibitors may be added to the fluid compositions of this invention for additional functional properties. The addition of such agents should be well known to one of skill in the art of formulating drilling fluids and muds. ... *Wetting agents and emulsifiers* that may be suitable for use in this invention *include, crude tall oil, oxidized crude tall oil, surfactants, organic phosphate esters, modified imidazolines and amidoamines, alkyl aromatic sulfates and sulfonates, and the like, and combinations or derivatives of these*. [Emphasis added.]

Accordingly, the emulsifying agent is disclosed in Patel to be selected from a number of possible emulsifying agents and need not be, e.g., VERSACOAT® surfactant. The emulsifying agent can instead be, e.g. a wetting agent or other non-surfactant emulsifier as listed by Patel.

Examiner respectfully draws Applicant's attention to paragraph [0032] on page 11 of the Applicant's specification:

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[0032] Other types of emulsion additives optionally may be added to the emulsion compositions of the present invention including, but not limited to, weighting agents, *wetting agents*, fluid loss agents, viscosifying agents, thinning agents, lubricants, anti-oxidants, *surfactants that are suitable for a purpose other than stabilizing an emulsion*, corrosion inhibitors, scale inhibitors, and the like. When used in certain applications, the emulsion compositions of the present invention may include particulates such as proppant or gravel. One of ordinary skill in the art with the benefit of this disclosure will recognize the appropriate type of additive for a particular application. [Emphasis added]

Therefore, because Patel discloses the emulsifying agent can be, e.g., a wetting agent (or other non-surfactant emulsifying agent) and Applicant's specification discloses wetting agents as an example of an emulsion additive for the claimed invention, then the instant claims remain anticipated by Patel.

The 35 U.S.C. 103 rejections over Patel and Perrin (item 14 of OA)

10. Applicant's arguments with respect to these 35 U.S.C. 103 rejection of claims 18, 22 and 35 as unpatentable over Patel and have been fully considered are deemed unpersuasive.

Applicant has not provided any arguments traversing any of the specific grounds of this rejection except to state that "Patel does not teach each and every limitation of independent claims 1 and 29" and that "Perrin [cannot] be used to provide the missing limitations." However, as shown above, Patel does anticipate the independent claims and the only "missing limitations" that Perrin needs to supply are regarding the emulsifier. As shown previously in OA regarding the instant rejection, Perrin, in combination with Patel, does "supply" these missing limitations.



Thus, because Applicants did not specifically address the merits of the grounds of this rejection, the claims remain unpatentable over Patel and Perrin.

*The 35 U.S.C. 103 rejections over Patel and Kokal (item 15 of OA)*

11. Applicant's arguments with respect to these 35 U.S.C. 103 rejection of claims 10 and 64 as unpatentable over Patel and Kokal have been fully considered and are deemed unpersuasive.

Applicant has not provided any arguments traversing any specifics of the grounds of this rejection except to state that "Patel does not teach each and every limitation of independent claims 1 and 63" and that "Kokal [cannot] be used to provide the missing limitations." However, as shown above, Patel does anticipate the independent claims and the only "missing limitation" that Kokal needs to supply is the breaker. As shown previously in OA regarding the instant rejection, Kokal, in combination with Patel, does "supply" this missing limitation.

Thus, because Applicants did not specifically address the merits of the grounds of this rejection, particularly regarding the breaker, the claims remain unpatentable over Patel and Kokal.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

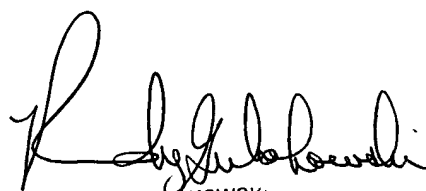
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs & alt. Fri 8:00-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG



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